

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

REIM-0002

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Signature

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Application Number

10/035,921

Filed

October 27, 2001

First Named Inventor

Senthil Kumar

Art Unit

3622

Examiner

John W. Van Bramer

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)



attorney or agent of record.

Registration number 33,182

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

David H. Hitt

Signature

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972-480-8800

Telephone number

August 18, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Senthil Kumar, *et al.*

Serial No.: 10/035,921

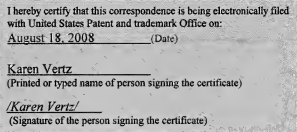
Filed: October 27, 2001

Title: REMOTELY CONFIGURABLE MEDIA AND ADVERTISEMENT
PLAYER AND METHODS OF MANUFACTURE AND OPERATION
THEREOF

Grp./A.U.: 3622

Examiner: John W. Van Bramer

Confirmation No.: 2210

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Applicants have carefully considered this Application in connection with the Examiner's Final Rejection mailed May 19, 2008 and the Advisory Action dated July 28, 2008, and respectfully request a Pre-Appeal Brief Review of this Application in view of the following remarks.

REMARKS/ARGUMENTS

The Applicants originally submitted Claims 1-21 in the Application. In previous responses, Claims 5, 12, and 19 were cancelled without prejudice or disclaimer, and the Applicants added new dependent Claims 22-24. In previous responses, Claims 1-4, 6-8, 15, and 21 were amended. Accordingly, Claims 1-4, 6-11, 13-18, and 20-24 are currently pending in the Application.

I. Rejection of Claims 1-4, 6-11, 13-18 and 20-24 under 35 U.S.C. §102 and §103

The Examiner has rejected Claims 1, 6, 8, 13, 15, 20 and 22-24 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,774,170 to Hite *et al.* (“Hite.”) The Examiner has rejected Claims 2-4, 7, 9-11, 14, 16-18 and 21 under 35 U.S.C. §103(a) as being unpatentable over Hite in view of U.S. Patent Publication 2002/0054087 to Noll, *et al.* (“Noll.”)

Hite is generally directed to television and radio advertising, delivering and displaying electronic commercials within specified programming one or more predetermined households while simultaneously preventing a commercial from being displayed in other households or on other displays for which it is not intended. (*See* Abstract.) In Hite, each commercial has an appended Commercial Identifier Code (CID). (*See* col. 3, lines 43-44.) At a point of usage, the CID codes are analyzed. When a match between the CID in the commercial and the CID stored at point of use is found, the advertisement is then presented to the viewer. (*See* col. 3, lines 3-8.) The commercials can also be preemptable as indicated by their CIDs. (*See* col. 3, lines 45-64.)

IA. Cited Portions of Hite Do Not Disclose “Playback Rules”

The Examiner contends that Hite discloses “playback rules” as claimed in Claim 1. The Examiner contends:

As disclosed in the cited reference of Hite, the CID codes are sent to individually addressable digital recording device with unique addresses that are installed at the display site.... Hite further discloses that attached to each commercial are codes indicating conditions and rules to *display the commercial*.... Thus playback rules are disclosed as required by the limitations of the claims as currently written. (*See* Advisory Action; emphasis added.)

The Applicants respectfully disagree with the Examiner. According to the present Application: “Playback rules govern how the *media* is distributed to the various media and advertisement players with which the remote system 110 interacts.” (*See* page 10, paragraph [0005].) “Accordingly, *playback rules* are designed to govern (1) which *media* is loaded into which media and advertisement players and (2) when the *media* is loaded.” (*See* page 11, paragraph [0007]; emphasis added.) “[T]he broad definition of ‘media’ includes informational or educational content, or any other content that may be desired to distribute to remote players. ‘Media’ is *not*, however, defined to include advertisements....” (*See* page 10, paragraph [0004]; emphasis added.)

According to M.P.E.P. ¶2111.01(IV) Applicant May Be Own Lexicographer: “Where an explicit definition is provided by the Applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).” In the present Application, the Applicants have defined “media” as to not include advertisements.

The Examiner is obliged to consider the claim as a whole. (See M.P.E.P. ¶2106(II)(C), citing *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 U.SP.Q. 1, 9 (1981).) When Claim 1 is read as a whole, the Examiner must find that cited portions of Hite disclose playback rules that govern (1) which *media* is loaded into which media and advertisement players and (2) when the *media* is loaded. Media is defined as not to include advertisements.

However, the Examiner is erroneously equating advertisements with media. (For example, see Advisory Action, citing to col.8, lines 18-39 of Hite, which is directed towards dynamically changing algorithms based on *commercials*.)

The cited portion of Hite reads in part:

The algorithm is created by the *advertisement* administrator and/or marketing organization that provides the commercials. The algorithm changes from time to time based on the nature of the *commercials* and the demographics of the viewers. The algorithm responds to information provided directly or indirectly by the viewer. This is a dynamic process. As the situation of the viewers changes, the *CIDs* [*Commercial Identifier Codes*] appropriate to those viewers also changes. (Emphasis added.)

Playback rules are explicitly defined in the present Application as directed towards playback rules of *media*, and media is explicitly defined as *not* including advertisements. Therefore, The Applicants request that the Examiner either meet his *prima facie* burden of proof regarding this claim, or allow the claim to issue.

IB. The Amendments of February 7, 2008 Should Be Afforded Full Patentable Weight

The Examiner has stated, regarding at least aspects of the claim Amendments of February 7, 2008, are not to be given substantial weight. In the Final Action of May 19, 2008, the Examiner stated:

[T]he examiner notes that the applicant is claiming a media and advertisement player, a method of manufacturing said player, and a method of playing media and advertisements. The newly proposed amendments directed towards the receipt of media, the receipt [of] advertisements or actions performed by other media players is outside the scope established by the preamble and as such bears little if any patentable weight regarding the limitations imposed by the current claims. (See Final Office Action, page 7.)

The Applicants previously disagreed with the Examiner regarding the above contention that the various amended elements should bear “little if any patent weight.” The Applicants previously

stated that they were unable to find support for this with the M.P.E.P. ¶2111.02 “Effect of Preamble” or elsewhere in the M.P.E.P., support for this interpretation of law.

In the Advisory Action, the Examiner states: “The Applicants arguments directed towards the effect of the preamble of unconvincing. The claim clearly recites a media and an advertisement player. If there was intended to be a plurality of media and advertisement players such a recitation is required.” The Examiner then generally directs the Applicants to M.P.E.P. ¶2173.05: “Specific Topics Related to Issues Under 35 U.S.C. 112, Second Paragraph.”

The Applicants again state that M.P.E.P. ¶2111.02, “Effect of Preamble,” or for that matter, within M.P.E.P. ¶2173.05 as generally cited by the Examiner, they have been unable to find support for the proposition of law that such a recitation is required in the preamble as asserted by the Examiner. Indeed, M.P.E.P. ¶2173.05(c) states: “A claim is *not* per se indefinite if the body of the claim recites additional elements which do not appear in the preamble.” (Emphasis added.)

The Applicants respectfully state that Claim 1 is directed towards a computer network, wherein a media an advertisement player have stored media content that are constrained by playback rules. The *playback rules* are directed to select among media content to be distributed, received, and stored among a plurality of media players, wherein the media player receives and stores, according to the playback rules, at least some different distributed media content than another of the plurality of the media players. The Applicants respectfully state that these patent elements are not indefinite and should be given full patentable weight.

IC. The Cited Portions of Hite Do Not Disclose Adjusting Playback Rules

The Examiner contends that Hite discloses adjusting playback rules in col. 8, lines 18-39 of Hite. (See Advisory Action.) The Applicants state that the Examiner has not addressed adjusting playback rules, but instead the cited portion of Hite is directed to a changing algorithm for selecting *advertisements*. Therefore, the Examiner has not addressed *adjusting playback rules* as claimed in Claim 1, either. Therefore, the Applicants respectfully request that the Examiner either meet his *prima facie* burden of proof regarding this claim, or allow the claim to issue.

ID. The Cited Portions of Hite Do Not Disclose an Advertising Schedule Correlated to Stored Media Content That Is Constrained By Playback Rules

As discussed above, the Examiner is obliged to consider the claim as a whole. (See M.P.E.P. ¶2106(II)(C), citing *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 U.S.P.Q. 1, 9 (1981).) When Claim 1 is read as a whole, the Examiner must find an advertising schedule is correlated to stored media content having *content constrained by the playback rules*. (Emphasis added.)

Instead, in Hite, transmissions are broadcasted to a plurality of households, with commercials being playable or preemptable based upon their CID. (See col. 5, lines 28-68). Although remote displays (“RDs”) may be mentioned in passages of Hite cited by the Examiner in the Final Office

Action, the Applicants are unable to find in the cited passages an advertising schedule that is correlated to stored media content having *content constrained by the playback rules*.

Instead, in Hite, in at least some embodiments:

the channels with preemptable and conditionally preemptable commercials are synchronized at the signal origination source so that enhanced advertising can be inserted *independent* of which program is be watched.... The consumer becomes more reachable even in an environment consisting of hundreds of channels.... This embodiment can be combined with any of the previous embodiments." (See col. 7, line 64-col. 8, line 18; emphasis added.)

To the contrary, in Claim 1, an advertising schedule is correlated to stored media content having *content constrained by the playback rules*. The Applicants request that the Examiner either meet his *prima facie* burden of proof regarding this claim, or allow the claim to issue.

IE. Rejection of Claims 1-4, 6-11, 13-18 and 20-24 under 35 U.S.C. §102 and §103 Are Not Supported

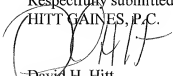
Therefore, the Examiner has not presented a proper *prima facie* case of anticipation or obviousness of the rejected claims. Furthermore, the cited portions of Hite, either individually or in combination with Noll, fail to teach or suggest the invention recited in independent Claim 1, and for similar reasons Claims 8 and 15, and their dependent claims, when considered as a whole. In view of the foregoing remarks, the cited references do not support the Examiner's rejection of Claims 1-4, 6-11, 13-18 and 20-24 under 35 U.S.C. §102(b) and 35 U.S.C. §103(a). The Applicants therefore respectfully request the Reviewers to withdraw the rejection and allow the claims to issue.

II. Conclusion

In view of the foregoing remarks, the Applicants see all of the Claims currently pending in this Application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1-4, 6-11, 13-18 and 20-24.

The Applicants request the Reviewers to telephone the undersigned attorney of record at (972) 480-8800 if such would further or expedite the prosecution of the present Application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,
HITT GAINES, P.C.


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Dated: August 18, 2008
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